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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,452	09/11/2003	Lutz Biedermann	7948/16	4918
757	7590	06/26/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE			WILLSE, DAVID H	
P.O. BOX 10395			ART UNIT	
CHICAGO, IL 60610			PAPER NUMBER	
			3738	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/660,452	Applicant(s) BIEDERMANN ET AL.	
	Examiner Dave Willse	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 9, 10 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8, 11-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4 pages total</u> . | 6) <input type="checkbox"/> Other: _____ |

Claims 1-6, 9, 10, and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 10, 2006.

In the Information Disclosure Statements of April 24, 2006 and May 15, 2006, certain references were not considered because a concise explanation of the relevance (37 C.F.R. 1.98(a)(3)) was not presented.

The disclosure is objected to because of the following informalities: On page 4, line 11, there should not be a space between "UHM" and "WPE"; on line 12, there should be a period at the end of the sentence; on line 14, "silicon" should be replaced by --silicone--. On page 5, line 17, "plan", both occurrences, should be replaced by --planar-- or --plane-- (or the Applicant should provide a dictionary definition, consistent with the context, of the term "plan"); other similar problems occur in paragraphs 0031 and 0040 of the specification; the term "plan-convex", however, is acceptable. On page 6, line 24, "silicone" is misspelled. In claim 7, line 1, "vertebral" is misspelled. In claim 18, line 1, "intervertebral" is misspelled. Other errors were noted. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 7, line 5, "its side" lacks a proper antecedent basis; on line 6, "the side" lacks a proper antecedent basis; on line 8, "the convex *part*" (emphasis

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added) lacks a proper antecedent basis. In claim 12, line 2, "its centre" lacks a proper antecedent basis; on lines 2-3, "an elastic intermediate layer" renders the claim vague and confusing relative to "an elastic layer" (claim 7, line 6).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).


Claims 7, 11-16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Bryan et al., US 2002/0128715 A1, which discloses a base plate **40**, a core **60**, and an adjoining

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top plate **20**. The core comprises various integral elastic layers by virtue of the coating (Figure 6; paragraph **0080**). Regarding claim 13, “the central body **60** is a preferably a donut-shaped structure” (paragraph **0078**, first sentence). Regarding claim 14, the central retaining post or sleeve **27** or **47** serves to limit relative movement between the base plate and the top plate about a central axis by helping to control the level of lubricant **80** and thus the tautness of sheath **70**; the geometries discussed in the last few sentences of paragraph **0088** would also limit such relative movement, particularly in view of Figures 8B and 9B. Regarding claims 15 and 16, the screws **28** and **48** and the connecting sleeves **27** and **47** likewise assist in connecting the base plate, the top plate, and the core together by limiting entry of fluid and by preventing expulsion of the central body **60** under extreme compression (paragraphs **0068** and **0096**). Regarding claim 18: paragraph **0097**.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan et al., US 2002/0128715 A1. Vertically extending teeth were well known in the art and would have been an obvious variant of or supplement to the “non-spherical sintered beads” (paragraph **0064**) in order to ensure adequate fixation, with motivation having been provided at paragraphs **0010**, **0013**, **0048**, and elsewhere.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
Art Unit 3738